

OHNISHI**Application No. 09/809,095****Response to Office Action dated October 11, 2005****Remarks**

Reconsideration and allowance of the subject patent application are respectfully requested.

An Information Disclosure Statement (IDS) was filed on October 27, 2005. Applicant respectfully requests that an initialed PTO-1449 form for this IDS be returned with the next office action.

Claims 26-30 were rejected under 35 U.S.C. Section 112, first paragraph, as allegedly failing to comply with the written description requirement. While not acquiescing in this rejection, claims 26-30 have been canceled without prejudice or disclaimer in order to expedite prosecution.

Claims 26-28¹ and 30 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Savitzky (U.S. Patent No. 6,571,271) in view of Hirokazu et al.² (JP 2000-75984). Claim 28 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Savitzky-Hirokazu combination, in further view of Morris et al. (U.S. Patent No. 6,097,389). While not acquiescing in these rejections, claims 26-30 have been canceled without prejudice or disclaimer to expedite prosecution. Thus these rejections are moot.

Claims 1, 3, 4 and 12 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. (U.S. Patent No. 6,097,389) in view of Hirokazu et al., further in view of Hirose (U.S. Patent No. 5,745,112).

Morris et al. discloses creating photo albums from various digital images. With reference to Figure 12B, the office action apparently contends that the images on the album page 807 are the claimed "reduced-size" images and that the thumbnails in the separate thumbnail region 809 are the claimed "file icons." In one described implementation, the assigned order of pictures in an album may be changed by dragging and dropping one of the "thumbnails" from a current position in the thumbnail region to another position in the thumbnail region. The picture album will then automatically and dynamically reposition the pictures in the album pages based on the changes made in the thumbnail region. See, e.g., col. 13, lines 36-61.

¹ Applicants believe the Examiner intended the statement of this rejection to refer to claims 26, 27, 29 and 30.

² "Hirokazu" appears to be the first name of the second inventor identified in JP 2000-075980.

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The office action acknowledges that Morris et al. is at least deficient with respect to disclosing the displaying of an icon concurrently with a reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each reduced-size image/file icon pair.

The office action references Hirokazu et al. to remedy this acknowledged deficiency of Morris et al.

Hirokazu et al. describes the use of so-called "markers" to purportedly facilitate the selection of one arbitrary graphic or one window from multiple graphics or windows displayed by overlapping them on the screen of a display unit. The office action alleges with reference to paragraph [0026] that "Hirokazu et al. teaches displaying the icon concurrently with the reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each of the reduced-size image/file icon pairs." However, paragraph [0026] does not describe the display position of the markers relative to the display position of the graphics to the same for each marker/graphic pair. Applicant notes that paragraph [0025] of Hirokazu states that "the operability of markers is considered to further improve it by controlling the display positions so as not to overlap with the indicated graphic." This seems to suggest that the display position of the graphic relative to the display position of the marker vary for the different ones of the marker/graphic pairs.

Moreover, claim 1 specifies that the reduced-sized image for each reduced-size image/file icon pair is displayed so that each file icon is between its corresponding reduced-size image and a second area of a display screen which includes a function icon. As described by way of example without limitation on pages 8 and 9 of the subject patent application, this can reduce problems associated with overlap of a reduced-size image (e.g., X1) and the functions icons (e.g., B1 to B5). Applicant finds no description of function icons in Hirokazu et al., much less any disclosure or suggestion about positioning the graphics or markers in consideration of the location of function icons.

Further, there is no apparent reason for modifying Morris et al. as proposed in the office action. In particular, Hirokazu et al. is intended to facilitate the selection of overlapping windows. Applicant does not find, and the office action does not identify, any such problem in Morris et al. that would be solved using the markers of Hirokazu. The office action conjectures

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that combining Hirokazu and Morris et al. would "simplify presentation and selection of images over the web." No explanation is offered as to why such simplifying would result from the proposed combination, nor is any such explanation apparent.

Hirose et al. is referenced in the statement of the rejection of claims 1, 3, 4 and 12, but there is no further mention of this document in connection with the rejection of these claims. Applicant respectfully submits that Hirose et al. does not remedy the above-noted deficiencies of the proposed Morris et al.-Hirokazu et al. combination.

For at least these reasons, Applicant respectfully submits that Morris et al., Hirokazu et al. and Hirose et al. would not have made claim 1 and its dependent claims 3, 4 and 12 obvious.

Claim 2 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Hirokazu et al. in view of Johnston, Jr. et al. (U.S. Patent No. 5,598,524) and Belfiore et al. (U.S. Patent No. 5,611,060). For the reasons set forth below, Applicant traverses this rejection.

Claim 2 is directed to an aspect of dragging of the file icon. Namely, if the drag operation is performed at a speed equal to or greater than a predetermined speed, the reduced-size image is fixed at a current position while a drag operation is performed. If the drag operation is below the predetermined speed, a frame having the size of the reduced-size image is displayed. The office action acknowledges that Morris et al. is deficient in this regard, but contends that Johnston, Jr. et al. and Belfiore et al. remedy this deficiency. However, neither of these references teach or suggest how to treat a reduced-size image when its corresponding file icon is dragged at particular speeds.

Johnston, Jr. et al. describes that a shape such as a rectangle may be used to represent a dragged object. However, Johnston, Jr. et al. does not relate this operation to the speed of dragging in any way, nor does Johnston, Jr. disclose how the appearance of a reduced-size image should vary when a corresponding file icon is dragged. Belfiore et al. describes that an auto-scrolling operation may be made to depend on the speed of a mouse indicator during a drag-and-drop operation. Here again, Belfiore et al. does not disclose or even suggest how the appearance of one object should change based on the dragging speed of some other object such as a file icon. There is no possibility that one of ordinary skill in the art would have arrived at the subject matter of claim 2 based on Johnston, Jr. and Belfiore et al. absent impermissible hindsight.

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For at least these reasons, the proposed combination of Morris et al., Hirokazu et al., Johnston, Jr. et al. and Belfiore et al. would not have rendered claim 2 obvious.

Claims 5-7 and 11 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Hirokazu et al. further in view of Hirose (U.S. Patent No. 5,745,112). For the reasons set forth below, Applicant traverses this rejection.

Claims 5-7 and 11 are directed to the concept of an icon return space. The illustrative, non-limiting, example embodiments of the subject patent application describe that when a file icon is dropped in an icon return space, the file icon is moved back to its original display position without moving the associated reduced-size image. See, e.g., page 9, line 25 to page 10, line 5. The office alleges that the dotted line in Figure 7 of Hirose et al. illustrate an icon return space. However, even assuming for the sake of argument that region 311 is argued to correspond to an icon return space, there is no disclosure of displaying such a space based on the distance of the file icon from a corresponding reduced-size image, nor does the office action address this feature of the claims. For at least these reasons, the proposed combination of Morris et al., Hirokazu et al. and Hirose would not have rendered the subject matter of claims 5-7 and 11 obvious. Applicant again respectfully requests that some evidence be provided in connection with displaying the icon return space based on the distance of the file icon from a corresponding reduced-size image as claimed.

Claim 8 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Hirokazu et al. in view of Hirose, and further in view of Aparicio, IV et al. (U.S. Patent No. 5,727,174). For the reasons set forth below, Applicant traverses this rejection.

Claim 8 specifies that the icon return space is larger in size than the file icon. This is shown and described in the illustrative example embodiments with reference to Figure 3(b) and its related description beginning at page 10, line 20. The office action alleges that the frame around the mini-desk 49 in Figure 6 of Aparicio, IV et al. is an icon return area that is larger in size than the file icon (human figure 47) to be returned thereto.

Claim 8 depends from claim 5 and Aparicio, IV et al. does not cure the deficiency of Hirose with respect to, among other things, displaying an icon return space based on the distance of a file icon from a corresponding reduced-size image. In addition, human assistant 47 is not a

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file icon associated with a reduced-size image of a data file. For at least these reasons, the proposed combination of Morris et al., Savitzky et al., Hirose and Aparicio, IV et al. would not have rendered claim 8 obvious.

Claims 9, 10, 13, 14 and 20-25 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Hirokazu et al. further in view of Johnston et al.

Claims 13, 24 and 25 specify particular positions for the reduced-size image, the file icon and the function icon (e.g., the file icon for each of the reduced-size image/file icon pairs is displayed so that each file icon is between its corresponding reduced-size image and a second area of the display screen which includes a function icon). Morris et al. and Hirokazu et al. are deficient with respect to these features for reasons similar to those discussed in connection with claim 1. The portion of Johnston, Jr. et al. referenced in the office action with respect to claim 13 relates to dragging an icon for a document to an icon for a printer. However, Johnston, Jr. et al. provides no disclosure or suggestion whatsoever with regard to reduced-image/file icon pairs or the arrangement of such pairs relative to a function icon(s). Thus, the addition of Johnston, Jr. et al. to the proposed Morris et al.-Hirokazu et al. combination would not have resulted in the subject matter of claims 13, 24 and 25.

Claims 9 and 10 depend from claim 1 and Johnston, Jr. et al. does not remedy the above-noted deficiencies of claim 1. As such, the addition of Johnston, Jr. et al. to the proposed Morris et al.-Hirokazu et al. combination would not have resulted in the subject matter of claims 9 and 10.

Similarly, claims 14 and 20-23 depend from claim 13 and are believed to be allowable because of this dependency and because of the other patentable features recited therein.

Claim 15 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Hirokazu et al.-Johnston et al. combination, in further view of Fleming (U.S. Patent No. 5,392,389). At least because Fleming does not remedy the deficiencies of the proposed Morris et al.-Hirokazu et al.-Johnston et al. combination with respect to claim 13 (from which claim 15 depends), Applicant respectfully submits that claim 15 is not rendered obvious as alleged in the office action.

Claims 16 and 17 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Hirokazu et al.-Johnston et al. combination, in further

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view of Hirose. At least because Hirose does not remedy the deficiencies of the proposed Morris et al.-Hirokazu et al.-Johnston et al. combination with respect to claim 13 (from which claims 16 and 17 each depends) and because of the deficiencies of Hirose noted above, Applicant respectfully submits that claims 16 and 17 are not rendered obvious as alleged in the office action.

Claim 18 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Hirose combination, in further view of Aparicio, IV et al. At least because Aparicio, IV et al. does not remedy the deficiencies of the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Hirose combination with respect to claim 16 (from which claim 18 depends) and because of the deficiencies of Aparicio, IV et al. noted above, Applicant respectfully submits that claim 18 is not rendered obvious as alleged in the office action.

Claim 19 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Hirokazu et al.-Johnston et al. combination, in further view of Belfiore et al. At least because Belfiore et al. does not remedy the deficiencies of the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Hirose combination with respect to claim 13 (from which claim 19 depends) and because of the deficiencies of Belfiore et al. noted above, Applicant respectfully submits that claim 19 is not rendered obvious as alleged in the office action.

New claims 31-37 have been added. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added.

Claim 31 depends from claim 1 and is believed to be allowable because of this dependency and because of the additional patentable features contained therein.

Claims 32, 34 and 36 specify certain relative positions of the reduced-size image, the file icon and the function icon which are not disclosed or suggested by the applied references (e.g., the file icon for each of the reduced-size image/file icon pairs is displayed so that so that each file icon is between its corresponding reduced-size image and a second area of the display screen which includes a function icon). As such, these claims and the claims that depend therefrom are believed to be allowable.

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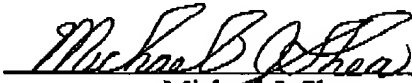
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For at least the reasons set forth above, the pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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